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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,629	05/14/2001	Morten Jorsboe	9192.15USWO	6531

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EXAMINER

KALLIS, RUSSELL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 08/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/762,629

Applicant(s)

JORSBOE ET AL.

Examiner

Russell Kallis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 25-73 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other.

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 25-32 and 68-73, drawn to a method of selecting transformed cells, a population of transformed/untransformed cells, and the transformed cell comprising a galactokinase.

Group II, claim(s) 25-32 and 68-73, drawn to a method of selecting transformed cells, a population of transformed/untransformed cells, and the transformed cell comprising a UTP-dependent pyrophosphorylase.

Group III, claim(s) 25-32 and 68-73, drawn to a method of selecting transformed cells, a population of transformed/untransformed cells, and the transformed cell comprising a UDP-glucose-dependent uridylyltransferase.

Group IV, claim(s) 25-32 and 68-73, drawn to a method of selecting transformed cells, a population of transformed/untransformed cells, and the transformed cell comprising a UDP-galactose epimerase.

Group V, claim(s) 25-32 and 68-73, drawn to a method of selecting transformed cells, a population of transformed/untransformed cells, and the transformed cell comprising a mutant galactokinase.

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Group VI, claim(s) 25-32 and 68-73, drawn to a method of selecting transformed cells, a population of transformed/untransformed cells, and the transformed cell comprising a mutant UTP-dependent pyrophosphorylase.

Group XII, claim(s) 25-32 and 68-73, drawn to a method of selecting transformed cells, a population of transformed/untransformed cells, and the transformed cell comprising a mutant UDP-glucose-dependent uridylyltransferase.

Group XIII, claim(s) 25-32 and 68-73, drawn to a method of selecting transformed cells, a population of transformed/untransformed cells, and the transformed cell comprising a mutant UDP-galactose epimerase.

Group IX, claim(s) 51-54 and 67, drawn to a transformed organism (plant) comprising a heterologously expressed galactokinase.

Group X, claim(s) 51-54 and 67, drawn to a transformed organism (plant) comprising a heterologously expressed UTP-dependent pyrophosphorylase.

Group XI, claim(s) 51-54 and 67, drawn to a transformed organism (plant) comprising a heterologously expressed UDP-glucose-dependent uridylyltransferase.

Group XII, claim(s) 55-66, drawn to a transformation construct.

The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The claims are not linked by a single special technical feature because the invention of Group I does not constitute an advance over the prior art. Group I broadly claims a method for selecting one or more genetically transformed cells from a population of cells that is taught by

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Christensen *et al.* who teach selection for transformed cells using phosphinothricin (Basta herbicide) and the phosphinothricin acetyltransferase gene (bar gene) in Transgenic Research 5, 213-218 (1996); Ubiquitin promoter-based vectors for high level expression of selectable and/or screenable marker genes in monocotyledonous plants. Hence, there is no special technical feature that links the method of Group I to the methods of Groups II-IX or to the transformed organisms of Groups IX-XI or to the transformation construct of Group XII. Furthermore, the methods of Groups I-VIII are distinct from Groups IX-XI and Group XII because the methods of Groups I-VIII, themselves distinct, each comprising a distinct heterologous enzyme, having either a unique biochemical mechanism, utilizing a different substrate, or producing at least one different product, are distinct from the transformed organisms of Groups IX-XI, themselves distinct in that they comprise unique heterologous enzymes, and the transformation construct of Group XII, that can be used in methods other than selecting for transformed cells and in transformed organisms; and hence, Groups I-XII do not relate to a single general inventive concept.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37) CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (703) 305-5417. The examiner can normally be reached on Monday-Friday from 8:30-5:00 PM.

If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone number for this Group is (703) 308-4242 or (703) 305-3014.

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Any inquiry of a general nature or relating to the status of this application, or if the examiner cannot be reached as indicated above, should be directed to the legal analyst, Kim Davis, whose telephone number is (703) 308-0009.

A handwritten signature in black ink, appearing to read "Amy Nelson", with a stylized flourish at the end.

Russell Kallis Ph.D.  
August 2, 2002

**AMY J. NELSON, PH.D**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**